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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,328	02/05/2004	Hiromi Tabuchi	1131-0500P	4066

2292 7590 04/19/2007

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EXAMINER	
EDEL, JOHN B	
ART UNIT	**PAPER NUMBER**
1731	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/19/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/19/2007.

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Office Action Summary	Application No.	Applicant(s)	
	10/771,328	TABUCHI ET AL.	
	Examiner	Art Unit	
	John B. Edel	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **1-2 and 3-10** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As for claims 1-2 and 3-10, Applicant has added to each independent claim a limitation relating to the inner wrapper of the cigarette being "without overlap of opposite side edges thereof." Applicant has not pointed out support for this limitation and examiner finds none in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims **1 and 4-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,494,055 to Noe et al ("Noe") in view of United States Patent pre-grant publication No. 2002/0074007 to Miyauchi ("Miyauchi").

As for claims 1 and 4, Noe teaches a rod shaped filler including tobacco, an inner wrapper wrapped around the rod shaped filler, outer wrapper surrounding the inner wrapper with a perfume layer in between which weakens the odor of the sidestream smoke [claim 1]. Miyauchi teaches the what is not expressly taught by Noe, namely a

polyvinyl acetate glue may be the carrier for the perfume material [abstract]. At the time of the invention, it would have been obvious to a person having ordinary skill in the art of cigarette manufacture to use a polyvinyl acetate glue as the carrier for the perfume material because the abstract of Miyauchi directly teaches such a method. Miyauchi and Noe are analogous because both relate to applying perfumes to tobacco products to improve side stream smoke. It would further be obvious to one having ordinary skill in the art of cigarette manufacture to cover the entire outer surface of the inner wrapper with the PVA glue because Noe discloses covering the entire surface of the inner wrapper [col. 4 lines 30-40] and because doing so would maximize the amount of perfume on each inner wrapper. It would still further be obvious to a person having ordinary skill in cigarette manufacture to provide an inner wrapper without overlap because such a configuration is one of a very limited number of design choices for the inner wrapper and such a configuration is less likely to give the appearance of an interior seam from the outside of the cigarette.

As for claim 5, Noe discloses microcapsules which could be classified as grains [col. 4 lines 40-50].

Claim **2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Noe and Miyauchi as applied to claim 1 above, and further in view of United States Patent No. 4,624,268 to Baker et al. ("Baker"). Baker teaches what is not expressly taught by Noe, namely that side stream reducing chemicals may be added to the cigarette paper [abstract]. At the time of the invention, it would have been obvious to a person having

ordinary skill in the art of cigarette manufacture to include such chemicals in the cigarette paper of Noe because doing so would be consistent with the aim of Noe, which is to reduce the effects of side stream smoke. Noe and Baker are analogous because both related to the reduction of the effects of side stream smoke in cigarettes.

Claim **6-8 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Noe and Miyauchi as applied to claim 1 above and further in view of United States Patent No. 2,999,520 to W. B. Lowman ("Lowman").

As for claim 6, Noe teaches a manufacturing machine for manufacturing double wrapper cigarettes having a first and second path for inner and outer wrappers, a wrapping section, a perfume supply device supplying perfume to one of the webs between the webs to weaken the odor of the sidestream smoke, and covering the entire inner surface of the inner wrapper [col. 4 lines 10-50]. Miyauchi teaches what is not expressly taught by Noe, namely that polyvinyl acetate glue is a good carrier of perfume [abstract]. At the time of the invention, it would have been obvious to a person having ordinary skill in the art of cigarette manufacture to use the glue perfume formulation of Miyauchi in the invention of Noe because Miyauchi describes such a technique as very effective method of applying perfume to reduce side stream smoke [paragraph 14]. Lowman teaches what is not expressly taught by Noe, namely that cutters are used in the later processing of tobacco within a cigarette machine [figure 3]. At the time of the invention, it would have been obvious to a person having ordinary skill in the art of cigarette manufacture to use a cutter such as the one found in Lowman because such a

device is necessary for the further processing into cigarettes. Lowman and Noe are analogous because both relate to cigarette manufacture. While Noe does not expressly teach "continuous" wrapping of cigarettes such wrapping is so notoriously well known in the art that a person having ordinary skill in the art of cigarette manufacture would read the teaching of combining with a cigarette rod machine [Noe col. 4 lines 10-50] as implying such a continuous nature.

As for claims 7 and 8, Noe further describes applying glue and spraying (diffusing) [col. 4 lines 10-50] which makes application with a nozzle obvious.

As for claim 10, Noe teaches feeding inner and outer webs, forming a double web in the claimed configuration, applying perfume to at least one of the the webs, supplying the tobacco material, and gluing over the entire surface of the inner web [col. 4 lines 10-50].

Claim **9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Noe, Miyauchi, and Lowman as applied to claim 8 above, and further in view of United States Patent No. 2,320,702 to Marchese et al. ("Marchese") and United States Patent pre grant publication No. US 20010009938 to Eckstein et al. ("Eckstein"). Eckstein teaches what is not expressly taught by Noe, namely that brush coating is customary in the paper industry [paragraph 110]. At the time of the invention, it would have been obvious to a person having ordinary skill in the art of cigarette paper processing to use a brush roller for the application of the perfume because Eckstein teaches such applications as customary [paragraph 110]. Eckstein is analogous to Noe because Eckstein relates to

a problem of Noe, namely what are the various ways that the desired compounds can be added to the paper. Marchese teaches what is not expressly taught by Noe, namely that surplus additive may be removed with a brush [page 2 col. 2 lines 48-52]. At the time of the invention, it would have been obvious to a person having ordinary skill in the art of cigarette paper processing to use a brush roller to remove excess additive from the cigarette paper because Marchese teaches such removal in the paper art. Marchese is analogous to Noe because Marchese relates to a problem of Noe, namely how can even distribution of additive be achieved.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Edel whose telephone number is (571) 272-4804. The examiner can normally be reached on 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBE

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